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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,485	08/14/2001	Takumi Oishi	ASAM.0018	7901
7590	12/22/2004		EXAMINER	
Stanley P. Fisher Reed Smith Hazel & Thomas LLP 3110 Fairview Park Drive, Suite 1400 Falls Church, VA 22042-4503			BATURAY, ALICIA	
			ART UNIT	PAPER NUMBER
			2155	
DATE MAILED: 12/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,485

Applicant(s)

OISHI ET AL.

Examiner

Alicia Baturay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-7 is/are rejected.
- 7) ☒ Claim(s) 1 and 3 is/are objected to.
- 8) ☒ Claim(s) 4 and 5 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11242004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-7 are pending.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3 and 6-7, drawn to a method of generating a second address in a first protocol corresponding to a first address in a second protocol, classified in class 709, subclass 245.
 - II. Claim 4-5, drawn to a method of providing protocol translation information at a translation server connected to a plurality of translators each performing a translation between a first protocol and a second protocol, classified in class 370, subclasses 465-467.
3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I does not require the use of protocol translation. The subcombination has separate utility such providing protocol translation between networks using differing communication methods.

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4. Because these inventions are distinct, each from the other for the reasons given above and the inventions have acquired a separate status in the art as shown by their different classifications restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Juan Carlos A. Marquez on 02 December 2004 a provisional election was made without traverse to prosecute the invention of T. Oishi and H. Inouchi, claims 1-3 and 6-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4 and 5 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Specification

8. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "A Method and System for Persistent Translation Between Protocols."

Drawings

9. The disclosure is objected to because of the following informalities: on page 16, line 28, Applicant states "...the packet destined for the terminal 41 transmitted from the terminal 42 is transmitted to the terminal 41 via translator 13 and the home agent 31." However, on Fig. 3, the path from element 42 through 31 to element 41 goes through translator 12. It is believed Applicant meant to show the path going through translator 13 on the drawing. Appropriate correction is required.

Claim Objections

10. Claim 1 is objected to because of the following informalities: Applicant states the following in part 2 of the claim, "...in said second protocol providing to said terminal." It is suggested that Applicant revise this to read "...in said second protocol *and* providing said second address to said terminal." Appropriate correction is required.
11. Claim 3 is objected to because of the following informalities: Applicant states "...in said second protocol provided to said translator." It is suggested that Applicant revise this to read

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“...in said second protocol *and* provided to said translator.” Appropriate correction is required.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, part 2 recites “said terminal” and it is unclear as to whether the first or second terminal is being specified.

14. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Claim 2 recites the limitations “second mobile terminal” and “second terminal.” There is insufficient antecedent basis for these limitations in the claim. However, it is noted that claim 1, part 1 discusses “a terminal” and “a first mobile terminal.”

16. Claim 6 recites the limitation “said second protocol.” There is insufficient antecedent basis for this limitation in the claim.

17. Claim 7 recites the limitation "the terminal accommodated in said first network." There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millet (U.S. 6,434,627) and further in view of Tsirtsis ("Network Address Translation - Protocol Translation (NAT-PT)").

20. As to claim 1, Millet discloses a method of translating addresses at a translator (Millet, Fig. 1B, element 111; col. 6, lines 22-25) connected to a first network (Millet, Fig. 1B, element 105; col. 6, lines 24-25) and to a second network (Millet, Fig. 1B, element 103), and to a translation server to which other translators are connected (Millet, col. 13, lines 57-62), said translator retaining translation information for a protocol translation between said first protocol and said second protocol (Millet, Fig. 7, element 715; col. 13, lines 30-32), the method comprising the steps of: detecting an address query of a terminal accommodated in said second network, from a first mobile terminal accommodated in said first network; generating a second address in said first protocol corresponding to a first address in said second protocol provided to said terminal (Millet, Fig. 7); retaining a correspondence

between said first address and said second address as said translation information (Millet, Fig. 7, element 715; col. 13, lines 30-32) and registering the correspondence between said first address and said second address at said translation server (Millet, col. 12, Lines 34-43). The embodiment of the address translation system on a router and several address translation lists being present inherently suggests that there are multiple translators that share their respective translation lists. Millet does not explicitly disclose the use of two differing protocols. However, Tsirtsis does discuss a process of translation of protocols (Tsirtsis, page 4, "Protocol Translation (PT)") for transferring data in a first protocol and for transferring data in a second protocol (Tsirtsis, page 4, "Protocol Translation (PT)"). It would have been obvious to combine the teachings of Millet and Tsirtsis to allow transparency protocol translation from the view of the client (Tsirtsis, page 2, paragraph 3).

21. As to claim 6, Millet-Tsirtsis discloses an address translation server connected to a first network (Millet, Fig. 1B, element 111) for transferring data in a first protocol, comprising a name of a terminal accommodated in a second network for transferring data in said first protocol, an address in said second protocol corresponding to said name (Tsirtsis, page 9, 2nd paragraph to the end), and a table containing a correspondence between said address and an address in said first protocol generated correspondingly to said address (Millet, Fig. 7, element 715).

22. As to claim 7, Millet-Tsirtsis discloses the invention substantially as described in claim 6, including an address translation server where the address in said first protocol is transmitted

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to said terminal upon receiving an address query for said name from the terminal accommodated in said first network (Tsirtsis, page 9, "The "A" record is then returned to Node-C.").

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millet-Tsirtsis and further in view of Vaudreuil.

25. As to claim 2, Millet and Tsirtsis (Millet-Tsirtsis) discloses the method of translating protocols where upon receiving a packet having said second address as a destination IP address from said second mobile terminal at the address in said first protocol in which a source IP address is provided to said second terminal as a result of a movement of said second mobile terminal which has been communicating with said terminal (Millet, col. 6, lines 53-60). However, Millet-Tsirtsis does not teach the use of multiple translators. However in analogous art, Vaudreuil teaches other translators (Vaudreuil, col. 7, lines 42-47), further comprising the steps of: inquiring of said translation server about address information of said terminal (Vaudreuil, col. 18, lines 17-22); receiving the correspondence between said first

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address and said second address registered by said other translators from said server (Vaudreuil, col. 7, lines 42-47); rewriting said destination IP address to said first address (Millet, col. 6, lines 53-60); and transmitting said rewritten packet to said terminal (Tsirtsis, page 9, last paragraph). It would have been obvious to those skilled in the art at the time the invention was made to combine Millet-Tsirtsis and Vaudreuil to facilitate communication between networks using differing protocols (Vaudreuil, col. 2, lines 6-9).

26. As to claim 3, Millet-Tsirtsis and Vaudreuil (Millet-Tsirtsis-Vaudreuil) disclose the invention substantially including the method of translating protocols where said source IP address is rewritten to the address in said second protocol provided to said translator (Tsirtsis, page 12, "Source Address").

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AB



**HOSAIN ALAM
SUPERVISORY PATENT EXAMINER**